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Facsimile: 503-228-9446

**FAX TRANSMITTAL**

**DATE:** April 17, 2003

**TO:** HOWARD J. LOCKER, EXAMINER  
GROUP ART UNIT 1661

**FAX PHONE:** 703-305-7401

**FROM:** Kenneth S. Klarquist

**RE:** U.S. Plant Patent Application No. 09/255,107  
Filed February 22, 1999  
CLIMBER ROSE PLANT NAMED HARYUP - HIGH HOPES

**OUR FILE:** 2747-51635

**NO. PAGES** 15 (including this cover page)

**PLEASE ACKNOWLEDGE RECEIPT BY RETURN FACSIMILE?** ☒ Yes ☐ No

**CONFIRMATION TO FOLLOW?** ☐ Yes ☒ No

**CONTACT INFO:** If you do not receive all pages or if you have problems receiving transmittal, please call us at (503) 226-7391 as soon as possible and ask for Dawn Vogt.

**MESSAGE:** Please see attached copies of the Transmittal Letter, Response to the Office Action dated November 15, 2002, Application No. NZ PBR ROS511 and GB Application No. 5/1357, that was submitted to the USPTO on December 27, 2002, as well as a copy of the returned postcard date-stamped by the OIPE on January 2, 2003.

CLIENT/MATTER NO. <u>2747-S1635</u>		ATTY/SEC <u>KSK-clm</u>
INVENTOR(S): <u>R. Harkness + P. Harkness</u>		
APP. NO. <u>09/855,107</u>		FILING DATE <u>2-22-99</u>
The following, due _____, mailed <u>12-27-03</u> <b>PF</b>		
by First Class Mail, was received in the U.S. PTO on the date stamped hereon: <b>JAN 02 2003</b>		
<input checked="" type="checkbox"/> Amendment	<input type="checkbox"/> Marked Up Claims/Spec.	<input type="checkbox"/> After Final Rejection
<input type="checkbox"/> Extension of Time/Extension Fee for _____ Months		
<input type="checkbox"/> Notice to File Missing Parts - Date _____		<input type="checkbox"/> Ltr to Draftsperson
<input type="checkbox"/> Notice to File Corrected App. Papers - Date _____		<input type="checkbox"/> Notice to Inventor
<input type="checkbox"/> Comb. Dec./POA	<input type="checkbox"/> Sht(s) Drawings	<input type="checkbox"/> Late Fee
<input type="checkbox"/> Issue Fee Transmittal (Form PTOL-85b)		<input type="checkbox"/> Sequence Listing _____ pages
<input type="checkbox"/> Supp. Dec.	<input type="checkbox"/> Issue/Adv. Order fees	<input type="checkbox"/> Stmt in Comp. _____ Disk
<input type="checkbox"/> IDS	<input type="checkbox"/> Form PTO-1449/Ref.	<input type="checkbox"/> Petition
Assignment to: _____		
<input checked="" type="checkbox"/> Transmittal Ltr. + <input checked="" type="checkbox"/> 1 _____ 2 copy(ies)		<input type="checkbox"/> Recordal Sheet
<input type="checkbox"/> Check No. _____ for \$ _____		<input type="checkbox"/> Request for Corrected Filing Receipt
<input checked="" type="checkbox"/> Deposit Acct. 02-4550 Authority		

KSK:clm 12/27/02 2747-51635 155212

PATENT

Attorney Reference Number 2747-51635

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert B. Harkness and  
Philip A. Harkness

Art Unit: 1661

Application No. 09/255,107

CERTIFICATE OF MAILING

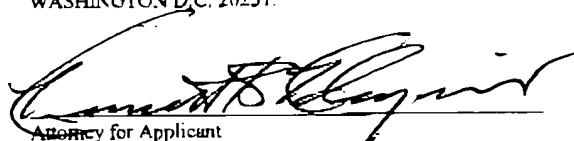
Filed: February 22, 1999

I hereby certify that this paper and the documents referred to as  
being attached or enclosed herewith are being deposited with  
the United States Postal Service on December 27, 2002, as  
First Class Mail in an envelope addressed to: BOX NON-FEE  
AMENDMENT, COMMISSIONER FOR PATENTS,  
WASHINGTON D.C. 20231.

For: CLIMBER ROSE PLANT NAMED  
HARYUP

Examiner: Howard J. Locker

Date: December 27, 2002

  
Attorney for ApplicantTRANSMITTAL LETTER

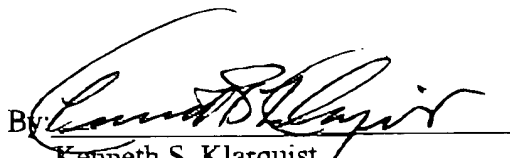
BOX NON-FEE AMENDMENT  
COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

Enclosed are the following:

- ☒ A Response to the Office Action dated November 15, 2002.
- ☒ Enclosed are copies of Application No. NZ PBR ROS511 and GB Application No. 5/1357, filed 23 October 1991.
- ☒ No additional fee is required.
- ☒ Please charge any additional fees that may be required in connection with filing this amendment and any extension of time, or credit any overpayment, to Deposit Account No. 02-4550. A copy of this sheet is enclosed.
- ☒ Please return the enclosed postcard to confirm that the items listed above have been received.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By   
Kenneth S. Klarquist  
Registration No. 16,445

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 226-7391  
Facsimile: (503) 228-9446  
cc: Docketing

\*\*\*\*\*  
\*\*\* RX REPORT \*\*\*  
\*\*\*\*\*

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RESULT	OK

KSK:clm 12/27/02 154950.doc  
PATENT

Attorney Reference Number 2747-51635  
Application Number 09/255,107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert B. Harkness and Philip A.  
Harkness  
Application No. 09/255,107

Art Unit: 1661

Filed: February 22, 1999

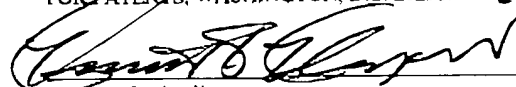
For: CLIMBER ROSE PLANT NAMED HARYUP

Examiner: Howard J. Locker

Date: December 27, 2002

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents  
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on December 27, 2002 as First Class Mail in an  
envelope addressed to:  
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FOR PATENTS, WASHINGTON, D.C. 20231.

  
Attorney for Applicant

BOX NON-FEE AMENDMENT  
COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

**RESPONSE**

Responsive to the Office Action of November 15, 2002, enclosed herewith are copies of  
Application No. NZ PBR ROS511 and GB Application No. 5/1357, filed 23 October 1991.

The undersigned was advised by Supervisory Examiner, Bruce Campell, that it would be  
necessary to file only the respective applications and it would not be necessary to file any further  
documents.

With respect to the quotation on page 2 of the Action, from page 12 of Appellants' Brief  
that "No one however skilled could have made, bred, or otherwise derived the HARYUP rose  
plant of this application from information in the publications relied upon by the Examiner," this  
is not inconsistent with the concession of the Examiner in the Office Action of June 28, 2002,  
that "the text of the relied upon publications standing alone would not enable one skilled in the  
art to practice the claimed invention." And it is submitted to be absolutely true that no one  
"could have made, bred, or otherwise derived the HARYUP rose plant . . . from . . . the  
publications relied upon by the Examiner." Multiplying the plant by asexual reproduction is not

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PATENT

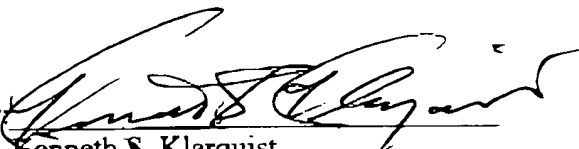
Attorney Reference Number 2747-51635  
Application Number 09/255,107

to make, breed or derive the plant. It was conceded in the Amendment of September 27, 2001, "that the rose variety of the subject application was placed on public sale in the United Kingdom in November, 1992." It is the applicants' position, which is believed to be in accordance with the law, that reproduction of the rose variety of the application by asexual reproduction is not the type of activity which places the invention "in possession of the public," which is the requirement of an enabling publication as set forth in In re LeGrice, 301 F2d 929, 133 U.S.P.Q. 365 (CCPA 1962) and the other authorities cited in Appellants' Brief to the same effect.

It is respectfully requested that an Answer be provided in a timely fashion to Appellants' Brief so that the Appeal can proceed in a timely fashion for consideration by the Board of Patent Appeals and Interferences.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By   
Kenneth S. Klarquist  
Registration No. 16,445

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 226-7391  
Facsimile: (503) 228-9446

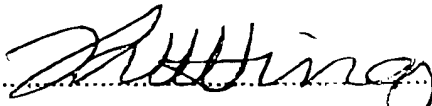
AFP 5/1357

PLANT VARIETY RIGHTS OFFICE

PLANT VARIETIES ACT 1997

CERTIFIED COPY OF AN APPLICATION FOR PLANT BREEDERS' RIGHTS

The Controller of Plant Variety Rights certifies that the attached document is a true copy of the application for plant breeders' rights accepted by him on 23 October 1991 from R Harkness in respect of the Rose variety known as HARYUP

  
for Controller of Plant Variety Rights

Date 6 Nov 2002

FROM : Harkness New Roses, France

PHONE NO. : 0033 492928215

Nov. 21 2002 03:23PM PS

(57)

Plant Varieties and Seeds Act 1964  
APPLICATION FOR PLANT BREEDERS' RIGHTS

Particulars of Applicant

1. Name and address of applicant.	HARKNESS NEW ROSES LTD 382 CAMBRIDGE RD HITCHIN, HERTS SG4 0JT
2. Address for service if different from that above. This address must be in the United Kingdom or the Isle of Man.	
3. Name and Address of breeder or discoverer if different from 1 above. (See Note 1.)	

Details of Plant Variety

4. Species or group of plant varieties to which the plant variety belongs.	ROSA
5. Proposed name or other designation.	MARYUP
6. Country in which the variety was bred or discovered.	U.K.
7. Have plants of the variety, or material forming part of or derived from them, been sold or offered for sale, either in the United Kingdom or the Isle of Man or abroad, prior to the date of this application?	(i) State YES or NO <u>No</u> If YES give the following particulars (ii) Country _____ (iii) Date of first sale or offer for sale _____ (iv) On what terms or conditions _____ (v) Has the breeder or discoverer given his consent? State YES or NO _____

Received	23.10.91	Initials	KT
Anticipated	25.10.91	Initials	KT
Accepted	23.10.91	Initials	KT

Applications outside the United Kingdom or the Isle of Man

8. (a) Give details of similar applications for rights in other countries	Country	Date	Name or designation applied for
(b) Is priority claimed in respect of an application or applications made in a designated country or countries in the 12 months preceding the date of this application?	State YES or NO _____ If YES, indicate below which of the applications detailed above are the subject of your claim.		

TQ 1

Nov. 21 2002 04:01PM PS

PHONE NO. : 0033 492928215

FROM : Harkness New Roses, France



I/WE declare that to the best of my/our knowledge and belief the statements made in this application are correct.

I/WE apply for the grant of plant breeders' rights.

Signature of applicant [Signature] ..... (See Note 2)

Date 11th Sept 1991 .....

To be completed by applicants requiring a Protective Direction

I/WE request that a protective directive be given in respect of the plant variety covered by this application. I/WE undertake that no plants of the plant variety, and no material forming part of, or derived from, plants of that variety, will be offered or exposed for sale or sold in the United Kingdom or the Isle of Man by me/us, or with my/our consent, in the period between the making of this application and the time when it is finally determined whether the application for plant breeders' rights is to be allowed or refused (or until this undertaking ceases to be binding under Schedule 1 of the Act whichever is the earlier).

I/WE understand that breach of this undertaking will render me/us liable to prosecution under the Act and may lead to the refusal of this application for the grant of plant breeders' rights or to termination of the period for which plant breeders' rights are exercisable, as the case may be.

Signature of applicant ..... (See Note 2)

Date .....

NOTES

1.
  - (i) Where the application is made by a person claiming to be the successor in title of the breeder, it must be accompanied by any assignment, probate, letters of administration or confirmation or such other documentary evidence as is sufficient to establish the title of the applicant.
  - (ii) Where the application is made by or through an agent it must be accompanied by an authority completed by the person on whose behalf the agent is authorised to act.
2. Where the application is completed by:-
  - (i) an individual person it must be signed by him;
  - (ii) a partnership firm it must be signed either by all the partners or by one of them on behalf of the firm;
  - (iii) a body corporate it must be signed by a director or by the secretary or other principal officer of the body corporate or by any other person satisfying the Controller that he is authorised to sign on behalf of the body corporate;
  - (iv) a society or other similar organisation it must be signed by someone satisfying the Controller that he is qualified to do so.
3. This application must be accompanied by the appropriate fee as laid down by the Plant Breeders' Rights (Fees) Regulations 1978:-
 

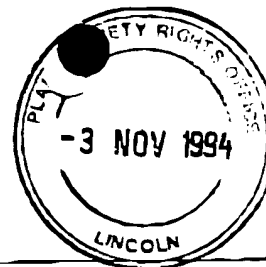
a)	for a cereal or potato variety	£100.00
b)	for a grass, legume or vegetable variety	£ 75.00
c)	for a fruit or decorative variety	£ 30.00

Attention is also drawn to the provisions of S.2(2) of the Plant Varieties and Seeds Act 1964 which stipulates that the applicant for rights must be the breeder or discoverer of the variety or his successor in title.

Plant Variety Rights Act 1987

**APPLICATION FOR PLANT VARIETY RIGHTS**

(Checklist and Instructions on reverse side.)



2/94

1. Owner(s): name(s) and address(es):

HARKNESS NEW ROSES  
THE ROSA GARDENS  
HITCHIN  
HERTS  
ENGLAND

(If NZ address)

telephone:

fax:

2. NZ address to which correspondence is to be sent (if different from 1.):

FRANK MASON & SON LTD.  
P.O. BOX 155  
FEILDING

telephone: 06 3235226 fax: 06 3235226

3. Kind of plant: Common name: ROSEBotanical name: Rosa4. (a) Proposed denomination (in block letters): HARYUP

(b) Breeder's reference (if any):

(c) Commercial synonyms (if any): HIGH HOPES

5. (a) Name and address of original breeder(s) (if other than owner(s)):

AS ABOVE

To the best of my(our) knowledge there is no other original breeder.

(b) If original breeder(s) other than owner(s), indicate whether the variety was transferred to owner(s) by:



contract



succession



other (specify)

6. Have applications for plant variety protection been made in other countries:



Yes



No

If "yes" give details below:

Country	Application date	Application No	Stage	Denomination (or breeder's reference)
UK	1992			HARYUP

Plant Variety Rights Office  
CERTIFIED TRUE COPY

Signed

(Instructions on reverse side)

7. Priority is claimed in respect of the application filed in (country) \_\_\_\_\_

on (date) \_\_\_\_\_ under the denomination \_\_\_\_\_

8. (answer both (a) and (b))

(a) The variety



has not been offered for sale or sold in New Zealand.



was offered for sale or sold in NZ for the first time on (date) \_\_\_\_\_

under the denomination HARYUP

(b) The variety



has not been offered for sale or sold abroad.



was offered for sale or sold abroad for the first time in

(country) 1993 UK.on (date) Oct. under the denomination HARYUP


9. Plant material

I/We declare that the material provided, or to be provided, in relation to this variety is, or will be, representative of the variety.

(Important: With certain kinds of plants a specified quantity of seed or colour photographs must be supplied at the time of application. See instructions.)

I/We apply for Plant Variety Rights.

I/We declare that, to the best of my/our knowledge, the information necessary for the examination of the application, given in this form and in any attachments is complete and correct.

Signature(s): Date: 18-10-94

Plant Variety Rights Office  
CERTIFIED TRUE COPY

Signed: 

(Refer to checklist on reverse of first page before lodging application.)

2/94

## NEW ZEALAND PLANT VARIETY RIGHTS OFFICE

## TECHNICAL QUESTIONNAIRE

To be completed in connection with an application for plant variety rights -

ROSE (Rosa L.)

1. Owner of variety: HARKNESS NEW ROSES  
THE ROSE GARDENS  
HITCHIN HERTS U.K.

2. Proposed denomination or breeder's reference:

HARYUD.

3. Information on origin of the variety:

a) Method of breeding or selection (tick appropriate box and give variety name(s) if relevant)

☐

Seedling of unknown parentage

☒

Produced by controlled pollination

Seed bearing parent COMPASSIONPollen parent CONQUERATORS☐

Produced by open pollination of \_\_\_\_\_

☐

Mutation or sport from \_\_\_\_\_

b) Other information -

4. Characteristics of the variety (mark the state of expression which best corresponds)

a) Growth habit -

narrow bushy

bushy

broad bushy

flat bushy

creeping

CAMPBELL

b) Flower type -

single

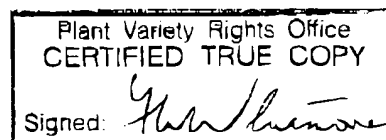
semi double

double

Plant Variety Rights Office  
CERTIFIED TRUE COPY

Signed: John Harkness

- c) Flower diameter -  
     very small  
     small  
     medium  
     large  
     very large
- d) Flower colour group -  
     white or near white (eg, Pascali, Iceberg, Pristine, Virgo)  
     medium yellow (eg, Goldilocks, Grandpa Dickson, Golden Masterpiece, Mobella)  
     deep yellow (eg, Kings Ransom, Friesia, Western Sun, All Gold, Sun King)  
     yellowblend (eg, Peace, Diamond Jubilee, Canary, Charleston, Mirza, Peer Gynt)  
     apricot blend, and  
     orange + orange blend (eg, Whisky, Apricot Prince, Apricot Nectar, Janina, Hot Pewter)  
     orange-red (eg, Orangeade, Spartan, Irish Mist, Satchmo, Julischka)  
     light pink (eg, Royal Highness, Bridal Pink, First Lady)  
     medium pink (eg, Queen Elizabeth, Percy Thrower, Vienna Woods)  
     pink blend (eg, Silver Lining, Chicago Peace, Pink Parfait)  
     light red + deep pink (eg, Peter Frankenfild, Prima Ballerina, Wendy Cussons, Pink Silk)  
     medium red (eg, Precious Platinum, Ena Harkness, National Trust, Melina)  
     dark red (eg, Europeana, Papa Meilland, Burgund, Deep Secret)  
     red blend (eg, Double Delight, Piccadilly, Strawberry Ice, Granada)  
     mauve (eg, Katherine Mansfield, Blue Moon, Sterling Silver)  
     russet (eg, Cafe, Fantan, Brownie)
- e) Growth type -  
     miniature (dwarf) (under 60cm height)  
     bush (bed) (60-150cm height)  
     shrub (over 150cm height)  
     climbing  
     ground cover
- f) Other characteristics of the variety -



## 5. Similar varieties and differences from these varieties:

Denomination of similar variety	Characteristic in which the similar variety is different	State of expression of similar variety	State of expression of candidate variety
PICTURE	COLOUR ONLY.		

## 6. Additional information which may help distinguish the variety:

## a) Resistance to pests and diseases -

Original stock plant (mature) has been  
shaped only twice over two seasons and  
has remained completely clean

## b) Special conditions for the examination of the variety. Use:

- ☒ in the open  
☐ under glass  
☐ as a pot rose

(Examination under glass or in pot must be requested only if the variety does not reveal distinguishing characteristics in the open air.)

## c) Other information -

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Plant Variety Rights Office  
 CERTIFIED TRUE COPY

Signed:

7. If the variety has been entered in the N.Z. National Rose Society merit trials give details.

- a) Date on which entered: JULY 1994
- b) Reference number in trials: NOT YET PROVIDED.
- 

Note: Colour photographs must be supplied at application. The following are the requirements that will apply.

Supply colour prints of minimum size 15cm x 10cm, not slides. Photographs should be of good quality and in duplicate. They should be representative of the variety and display as well as possible its chief distinguishing feature(s). The photographs may be of the whole plant of the new variety and/or of plant parts such as the fruit or the flowers, whichever is most appropriate. Do not supply photographs of the original bred or discovered plant of the variety, or in the case of a new mutation or sport the plant part from which the variety originated. Instead you should supply photographs based upon plants or trees propagated from the original plant or plant part.

Signature: \_\_\_\_\_

Date: \_\_\_\_\_

Plant Variety Rights Office  
CERTIFIED TRUE COPY

Signed: \_\_\_\_\_



PLANT VARIETY RIGHTS OFFICE  
NEW ZEALAND

GRANT OF PLANT VARIETY RIGHTS

No. 1131

Pursuant to the Plant Variety Rights Act 1987 a grant of  
PLANT VARIETY RIGHTS is hereby made to

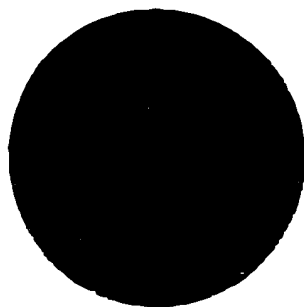
HARKNESS NEW ROSES LTD

in respect of the rose variety

HARYUP

for a term of 23 years from the

15th day of August 1996



A handwritten signature in black ink, appearing to read "John Hutcheon".

Commissioner of Plant Variety Rights